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OFFICE OF PETITIONS

In re Application of :
Nigshiguchi, et al. :
Application No. 09/842,542 : **DECISION ON PETITION**
Filed: 26 April, 2001 :
Patent No. 7,330,553 :
Issue Date: 12 February, 2008 :
Attorney Docket No. 277923US6DIV :

This is a decision on the petition under 37 C.F.R. §1.181(A)(2), filed on 23 June, 2008, considered also a petition pursuant to 37 C.F.R. §1.182, and 37 C.F.R. §1.183, requesting that a terminal disclaimer recorded in prior-filed Application No. 07/600,818 (the '818 application), filed on 22 October, 1990, which issued as U.S. Patent No. 5,640,458 (the '458 patent), on 13 June, 1994, be withdrawn or nullified with regard its effect on the term of this patent.

The petition pursuant to 37 C.F.R. §1.181 is **DISMISSED**; the petition as considered under 37 C.F.R. §1.182 is **DISMISSED**; and the petition as considered under 37 C.F.R. §1.183 is **DISMISSED**.

Petitioner requests that the Director nullify any effect of the terminal disclaimer filed on 13 June, in the above-referenced prior-filed '818 application on the '758 patent, which issued from Application No. 08/887,417 (the '417 application).

Petitioner states:

Initially, Patentee respectfully request that 37 C.F.R. §1.182(f) (sic) [1.181(f)] be suspended. Rule 182(f) (sic) [1.181(f)] indicates that a petition not filed within two months of the action or notice from which relief is sought may be dismissed as untimely. However, under 37 C.F.R. § 1.183, the Director, or the Director's designee, may suspend or waive a Rule in the event of extraordinary circumstances or when justice requires. Patentee submits that the present situation is such a case.

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Petitioner's argument was considered but was not persuasive.

Petitioner cites to the Commentary at MPEP §1490.

The guidance in the Commentary at MPEP §1490 provides in pertinent part:

While the filing and recordation of an unnecessary terminal disclaimer has been characterized as an "un-happy circumstance" in In re Jentoft, 392 F.2d 633, 157 USPQ 363 (CCPA 1968), there is no statutory prohibition against nullifying or otherwise canceling the effect of a recorded terminal disclaimer which was erroneously filed before the patent issues. Since the terminal disclaimer would not take effect until the patent is granted, and the public has not had the opportunity to rely on the terminal disclaimer, relief from this unhappy circumstance may be available by way of petition or by refiling the application (other than by refiling it as a CPA).

The mechanisms to correct a patent — Certificate of Correction (35 U.S.C. 255), reissue (35 U.S.C. 251), and reexamination (35 U.S.C. 305) — are not available to withdraw or otherwise nullify the effect of a recorded terminal disclaimer. As a general principle, public policy does not favor the restoration to the patent owner of something that has been freely dedicated to the public, particularly where the public interest is not protected in some manner — e.g., intervening rights in the case of a reissue patent. See, e.g., Altoona Publix Theatres v. American Tri-Ergon Corp., 294 U.S. 477, 24 USPQ 308 (1935). (Emphasis supplied.)

Petitioner must show why the terminal disclaimer filed in the '818 application, to which the subject application claims benefit under 35 U.S.C. §120, should not be given full effect in the succeeding patents, including the '553 patent, which issued from the '542 application.

The decision in the '458 patent concerning the petition to withdraw the terminal disclaimer set forth the reasons why the terminal disclaimer will not be withdrawn or nullified in the '818 application/the '458 patent.

It is noted that there is a consistent result as to the effect of the terminal disclaimer filed in the '818 application can be nullified or withdrawn with regard to Patent No. 7,337,027 (the '027 patent), which issued from Application No. 11/158,880 (the '880 application, an application claiming benefit under 35 U.S.C. §120 to the '818 application.

The terminal disclaimer filed on June 13, 1994, in the '818 application states that Petitioner "hereby disclaims the terminal twenty-six (26) months of any patent granted on Application Serial No. 07/600,818 or on any application which is entitled to the benefit of the filing date of said Application No. Serial No. 07/600,818 under 35 U.S.C. §120."

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In claiming the benefit under 35 U.S.C. §120 of the '818 application in the '880 application, Petitioner acquiesced to any and all limitations on the patent term of any patent issuing from the '880 application, as imposed by the terminal disclaimer filed in the '818 application.

Again: public policy, as a general principle, does not favor the restoration to the patent owner of something that has been freely dedicated to the public, particularly where the public interest is not protected in some manner — e.g., intervening rights in the case of a reissue patent. See, e.g., Altoona Publix Theatres v. American Tri-Ergon Corp., 294 U.S. 477, 24 USPQ 308 (1935).

The balance of equities does not merit the Director overruling the well-settled public policy that precludes restoration to the patent owner of something that has been freely dedicated to the public in favor of correcting after issuance of the patent—and a period of delay. The showing of record is that Petitioner did not file the petition to withdraw the terminal disclaimer in the '818 application until an extended period after the '458 patent had issued, and has not provided an adequate explanation of neither the delay in filing the petition, nor a sufficient reason why the Director should grant the requested relief under 37 C.F.R. 1.182.

Considered pursuant to 37 C.F.R. §1.183, Petitioner's argument is not persuasive.

The regulations at 37 C.F.R. §1.183 provide that in an extraordinary situation, when justice requires, a requirement of the regulations which is not statutory may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed.

The facts presented on the record do not establish an extraordinary situation. Petitioners have not established any special circumstances or equities that would require suspension of the rules in the interests of justice. It is noted that Petitioner has not identified a particular rule the waiver of which would provide the relief requested.

Moreover, 35 U.S.C. §120 states that an application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of Title 35 U.S.C. in an application previously filed in the United States, or as provided by section 363 of Title 35 U.S.C., which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

Thus, to the extent that the term of the '458 patent is limited by the terminal disclaimer filed in the '818 application and the '553 patent claims benefit of the '818 application under 35 U.S.C. §120, the claim of benefit is statutory.

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Accordingly, the Office lacks the authority or discretion to relax any requirement of law.¹ The Office is an executive branch agency, and so the Office must follow the strict provisions of the applicable statute.

As such, to the extent that the '458 patent which issued from the '818 application, to which the '542 application claims benefit under 35 U.S.C. §120, is subject to the terminal disclaimer at issue, any patent which issued from an continuing application filed under 35 U.S.C. §120, which claims the benefit of the '818 application, is, by statute, subject to all of the limitations which apply to the '818 application, the '458 patent, and any applications for patent claiming benefit under 35 U.S.C. §120 thereto—including the instant '542 application, which issued as the '553 patent.

CONCLUSION

Accordingly, the petition pursuant to 37 C.F.R. §1.181 is **dismissed**; the petition as considered under 37 C.F.R. §1.182 is **dismissed**; and the petition as considered under 37 C.F.R. §1.183 is **dismissed**.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
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 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-8300
 Attn: Office of Petitions

By hand: Customer Service Window
 Mail Stop Petition
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

¹ See: *Baxter Int'l, Inc. v. McGaw, Inc.*, 149 F.3d 1321, 1334, 47 USPQ2d 1225, 1234-1235 (Fed. Cir. 1998)(the PTO cannot, by rule, or waiver of the rules, fashion a remedy that contravenes 35 U.S.C. §§ 112, 120); *A. F. Stoddard v. Dann*, 564 F.2d 556, 566, 195 USPQ 97, 105 (D.C. Cir. 1977)

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Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2²) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's/Caller's action(s).



/John J. Gillon, Jr./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

Conferee: Anthony Knight, Supervisor, Office of Petitions

² The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.